

REMARKS

This is intended as a full and complete response to the Final Office Action dated September 12, 2006, having a shortened statutory period for response set to expire on December 12, 2006. Applicants submit this response to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 9-24, 26-27 and 29-31 are pending in the application. Claims 9-24, 26-27 and 29-31 remain pending following entry of this response. Claims 9, 11, 12, 17, 19, 20, 24, 26, 27, 29 and 31 have been amended. Applicants submit that the amendments do not introduce new matter and do not require further search or consideration, as the amendments are made pursuant to explicit requests from the Examiner and/or to make explicit what was already implicit.

Claims Objections

Claims 9, 11-12, 17, 19, 20, 24 and 26-27 are objected to because of the following informalities:

Claims 9, 12, 17, 24 and 27 objected to because ...the recitation of "only if" makes the statement(s) following the recitation totally optional.

Claims 20 and 27 recite the word "for" in the claims. It indicates intended use and as such does not carry patentable weight.

Claims 9, 17, 19, 24, 26-27, and 29 recite, "allowing" or "allow". Allowability does not mean that the step is being accomplished. It suggests a capability but not necessarily taking place.

Claim 26 introduces "an interface." An interface is provided in parent claim 24.

Claim 11 states the intended use by use of word "using." To overcome this type of rejection, claims could be amended to recite definite functionality.

Claims 9, 11-12, 17, 19, 20, 24 and 26-27 have been amended according to Examiner's suggestions. Accordingly, Applicants respectfully request withdrawal of these objections.

Claim Rejections - 35 U.S.C. § 112

Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claim 24 is rejected for not having support for "tangible" medium. Examiner suggests that "the word 'tangible' should be deleted [from claim 24]. To meet the requirement 'computer-readable storage medium' is enough." Claim 24 has been amended according to Examiner's suggestion. Accordingly, Applicants respectfully request withdrawal of this rejection.

Claims 9, 17, 24 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner takes the position that "Claims 9 and 17 recite 'second view of data' in the body of the claims. The claims do not show how this view is obtained or what is meant by second view." Applicants respectfully traverse this rejection.

First, Applicants submit that the terms at issue are understandable according to their ordinary and customary meaning. A "view of data" is understood as a visual representation of data. First and second merely designate different views separated by time (first occurs before second). Second, Applicants submit that the terms at issue are understandable according to the meaning given by the Applicants' disclosures. As noted in MPEP § 2173.01,

A fundamental principal contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specifications.

Therefore, rejections for indefiniteness under § 112, second paragraph would be improperly applied to claim terms which have special meaning clearly set forth in the specifications.

Paragraph [0007] of the specifications functionally defines “a view” as desired data returned by a query in a concise format. Paragraph [0034] and Figure 2A describe how the linking component receives a set of cells visible in the annotated portion of the view 122A (“first view of data”). Paragraph [0035] and Figure 2B then describe the analysis of a subsequent view of data, 122C (“second view of data”), to determine whether to display a previously generated view annotation. Paragraph [0042] makes the relationship explicit: “After an annotation has been attached to a first view of data via operations 302-306, operations 308-312 may be performed to determine if the annotation should be displayed for a second (subsequent) view of data.”

The specifications clearly set forth any special meaning assigned to “second view of data” and the rejection is, therefore, improper. Nevertheless, in order to move prosecution along, Applicants have made explicit what was implicit in their defined terms. Accordingly, Applicants respectfully request withdrawal of this rejection.

The Examiner takes the position that “Claim 24 state ‘for associating’ in the preamble. The body of the claim never actually does the associating. There is no nexus between preamble and body of claim and it does not achieve the intended use of structuring data as recited in preamble.” Applicants respectfully submit that the “association” is clearly set forth in the body of the claim and the specifications.

In the body of the claim, association of an annotation with an annotated portion occurs in the operation of “creating a record containing the annotation and the link to each cell in the annotated portion”. The record thereby represents the association of the annotation to the annotated portion. Paragraphs [0031]-[0032] of the specifications further clarify this association.

Therefore, the body of the claim and the specifications clearly set forth any special meaning assigned to “association”. Applicants respectfully request withdrawal of this rejection.

The Examiner fails to state a specific reason for finding claim 27 to be indefinite. According to MPEP § 2173.02,

If upon review of a claim in its entirety, the examiner concludes that a rejection under § 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office Action.

Applicants believe the claim to be definite, and respectfully requests withdrawal of this rejection.

Claim Rejections - 35 U.S.C. § 101

Claims 17 and 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The Examiner takes the position that

Claims 17, and 24 list computational steps in a program without tangible, useful, concrete result. The claims do not have any visible result or output.

The steps of "indicating" are missing real world result. Indicating doesn't actually have show or output the result of determination. There needs to be an outputting or storing for further use.

The claims have been amended to clarify the "real world result" of providing the user with valuable information, namely, an indication of the annotation when a predetermined set of cells visible in the second view of data are visible in the referenced portion of the first view of data.

Applicants therefore believe that the claims, as amended, are directed to statutory subject matter, and Applicants respectfully request withdrawal of the rejection.

Claim Rejections - 35 U.S.C. § 102

Claims 9-10, 12-22 and 24, 26-27, 29-30 rejected under 35 U.S.C. 102(e) as being anticipated by *Bays et al.* (US 2003/0018632 (hereinafter, "*Bays*")).

Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, *Bays* does not disclose "each and every element as set forth in the claim." As discussed in the Response to Office Action dated March 22, 2006, *Bays* does not disclose "analyzing the second view of data to identify sub-objects visible in both the second view of data and the annotated portion of the first view of data". Applicants respectfully reassert this position.

In the current Office Action, Examiner's Response to Arguments states,

As to the analysis of second view in regards to teachings of *Bays et al.* (US 2003/0018632 A1), since the second view has not been explained, the examiner interprets *Bays* teaching on page 3 paragraph 0038 lines 10-16 as pertinent to the limitation. If annotations are retrieved, if they exist, then they can be filtered and or modified depending on the context of the reader.

As discussed in the section of this Response to Office Action dealing with Section 112 claim rejections, the claims and specifications fully explain both the ordinary and customary meaning, and any special meanings of "second view". Moreover, in order to move prosecution along, Applicants have made explicit what was implicit in the defined terms. In light of these explanations, Applicants respectfully disagree with the Examiner's interpretation of *Bays*' teaching of paragraph [0038].

In paragraph [0038], *Bays* discloses retrieval of annotations. However, the cited paragraph does not disclose a process for determining which annotations to retrieve. In particular, *Bays* does not discuss *analyzing the second view of data* as a process to determine which annotations to retrieve. Rather, *Bays* requires the user to ask "for the accompanying annotations with particular characteristics" (*Bays* [0022]). The current application relieves the user of that step, by automatically displaying (or otherwise indicating) when a second view of data contains a common set of objects also contained in the annotated portion of the first view of data (Figures 4A and 4D of the

current application). Consequently, it should be clear that *Bays* does not disclose analyzing the second view of data to identify sub-objects visible in both the second view of data and the annotated portion of the first view of data.

Because *Bays* fails to teach each and every element, Applicants submit this claim and its dependents are allowable. Accordingly, withdrawal of this rejection is respectfully requested.

Allowable Subject Matter

Claims 11, 23 and 31 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

In light of the previous traverses to Examiner's rejections under 35 U.S.C. § 112, second paragraph, Applicants believe claims 11, 23 and 31 to be allowable, and respectfully requests allowance of these claims.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

If the Examiner believes any issues remain that prevent this application from going to issue, the Examiner is strongly encouraged to contact Gero McClellan, attorney of record, at (336) 643-3065, to discuss strategies for moving prosecution forward toward allowance.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

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